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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN K. CHAN and LAWRENCE F. CHU

Appeal 2009-000926
Application 09/844,933
Technology Center 3600

Decided:¹ May 27, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Bryan K. Chan, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-54. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention is a system that collects personal health information and medical record data, analyzes the information, and makes recommendations that include computer generated recommendations and input from participating third parties, such as doctors. Specification [0007].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for managing diseases and wellness online, the method comprising:

receiving patient data over a network from a user regarding a health condition being experienced by the user;

filtering the patient data according to a first database to produce filtered patient data, wherein the filtering of the patient data comprises:

² Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Nov. 5, 2007) and the Examiner's Answer ("Ans.," mailed Apr. 1, 2008).

discarding some of the patient data
that is not so related to the health condition;
and

requesting correction or verification
on some of the patient data with the user
when the patient data appears abnormal
according to the first database;

performing an analysis of the filtered patient
data, the analysis including one or more of
statistical analysis implemented based on a survey
among a group of similar people with respect to
the health condition in the filtered data, data
variability analysis, trend forecasting, significance
of data, distribution of data, projection of data,
computation of trends, linear and non-linear
regression techniques, curve-fitting methods, or
numerical analyses;

outputting directly to the user, in response to
the filtered patient data, a medical
recommendation of the health condition based on a
second database that includes medical decision-
making intelligent agents, accesses to clinical
research information, related health databases or
resources controlled by various professional
participants, wherein the medical recommendation
includes what the user is suggested to do in
regarding to the health condition; and

alerting automatically through the network
related parties regarding the user if the health
condition is deemed to be attended by
professionals.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Campbell	US 6,047,259	Apr. 4, 2000
Joao	US 6,283,761 B1	Sep. 4, 2001
LaPointe	US 2001/0023419 A1	Sep. 20, 2001

William R. Hendee and Peter N.T. Wells, eds., *The Perception of Visual Information*, 326 (1997) (hereinafter “Hendee”).

The following rejections are before us for review:

1. Claims 1-9, 18-29, 38-46, and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell, and Hendee.
2. Claims 10-17, 30-37, and 47-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell, Hendee, and LaPointe.

ARGUMENTS

The Appellants argue that the Examiner has failed to establish a prima facie case of obviousness in rejecting independent claims 1, 21, and 38 (Br. 14) for the following reasons:

First, the Appellants argue that the instant invention differs from Joao in that the instant invention is directed to providing a self-care mechanism for a patient to manage his/her own diseases so that a medical recommendation is produced without physician input and is provided directly to the patient. Br. 9. The Appellants assert that Joao’s method, which is depicted in Figures 7A and 7B, clearly teaches a physician and not a patient using the system. *Id.* The Appellants also assert that neither

Hendee nor Campbell teach this difference. Br. 12-13. Based on this difference, the Appellants argue 1) that every element of the claimed invention is not taught and 2) that Joao teaches away from a combination where a patient uses the system as a self care mechanism. Br. 9-10.

The Examiner responds that claim 1 does not require a step of a patient managing a disease by themselves. Ans. 19.

Second, the Appellants argue that Joao's reports cannot be considered the claimed medical recommendations that include what the user is suggested to do in regards to the health condition. Br. 10-11. The Appellants state "[t]he instant application teaches outputting a 'medical recommendation' that suggests what the user (e.g., patient) should do next, not just a simple diagnosis or a list of possibilities." Br. 10.

Third, the Appellants argue that the combination of Joao and Campbell does not describe altering related parties automatically if the data provided by the patient is abnormal. The Appellants argue that Joao does not describe "that related parties will be automatically contacted *if the data provided by the patient is abnormal*, while Joao only shows that all computers that are connected will receive various messages." (Emphasis original.) Further, the Appellants argue that Campbell while describing marking data normal or abnormal for a doctor, Campbell does not describe a notification process. Br. 11.

The Examiner responds that claim 1 does not require this limitation (Ans. 19) and that Joao teaches the limitation as claimed (Ans. 20).

We note that the Appellants do not separately argue dependent claims 2-20, 22-37, and 39-54. Br. 8-14.

ISSUES

The issues are:

(1) Do the claims 1, 21, and 38 recite a self-care mechanism for a patient to manage his/her own diseases so that a medical recommendation is produced without physician input and is provided directly to the patient and, if so, would one of ordinary skill in the art have been led by Joao, Campbell, or Hendee to the recitation?

(2) Do the reports described in Joao meet the claimed limitations of claims 1, 21, and 38 of a medical recommendation that includes what the user is suggested to do in regards to the health condition?

(3) Do the claims 1, 21, and 38 require that related parties be automatically contacted *if the data provided by the patient is abnormal* as argued by the Appellants, and, is so, would one of ordinary skill in the art have been led by Joao and Campbell to this limitation?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method including the step of “receiving patient data over a network from a user regarding a health condition being experienced by the user.”

2. Claim 1 recites “requesting correction or verification on some of the patient data with the user when the patient data appears abnormal according to the first database.”
3. Claim 1 recites “outputting directly to the user, in response to the filtered patient data, a medical recommendation.”
4. Claim 1 recites “wherein the medical recommendation includes what the user is suggested to do in regarding [*sic.*] to the health condition.”
5. Claim 1 also recites “alerting automatically through the network related parties regarding the user if the health condition is deemed to be attended by professionals.”
6. Claim 21 recites a method including “maintaining an account associated with a user having a health condition.”
7. Claim 21 recites “requesting correction or verification on some of the patient data with the user when the patient data appears abnormal according to the first database.”
8. Claim 21 recites “receiving data from the user in response to the questions, wherein the data includes answers to the questions and diagnostic data if received from a diagnostic test device pertaining to the health condition.”
9. Claim 21 recites “providing directly to the user a medical recommendation” and “wherein the medical recommendation includes what the user is suggested to do in regarding [*sic.*] to the health condition.”
10. Claim 21 also recites “alerting related parties regarding the user if the health condition is deemed to be attended by professionals.”

11. Claim 38 recites a machine-readable medium including code for performing the steps of claim 1.

The scope and content of the prior art

Joao

12. Joao describes a method of diagnosing a condition in Figures 7A and 7B.
13. Figure 7A is reproduced below.

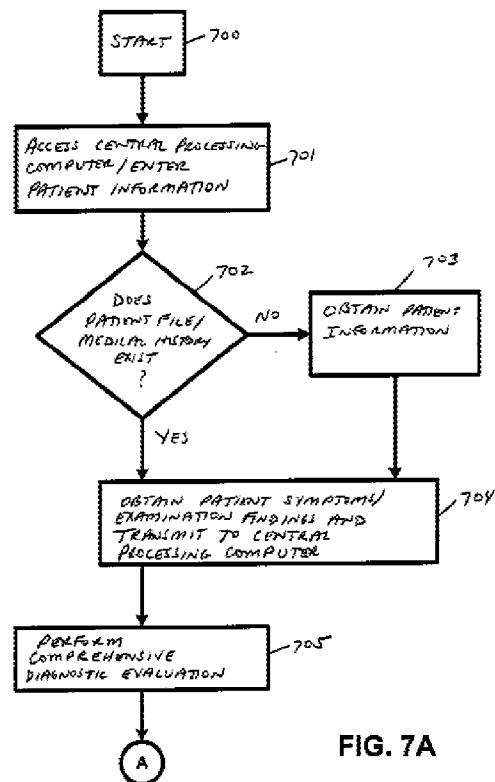


Figure 7A depicts steps 700-705 of the method in a flow diagram form.

14. Figure 7B is reproduced below.

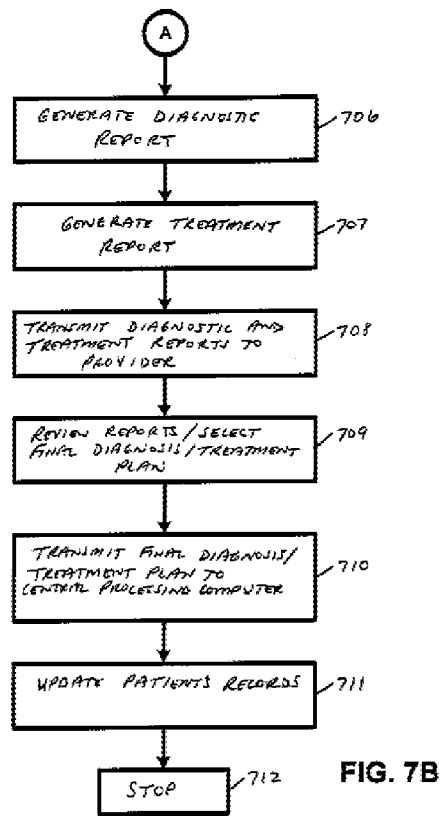


Figure 7B depicts steps 706-712 of the method in a flow diagram form.

15. Joao describes obtaining patient information from a provider, including symptoms, and transmitting the patient information to a central processing computer 10 at step 704. Col. 25, ll. 27-30.
16. Joao describes the central processing computer 10 performing a comprehensive diagnostic evaluation using the information using the patient information, medial history and medical information at step 705. Col. 25, ll. 30-38.
17. Joao describes the central processing computer generating a diagnostic report, which includes a diagnosis of the patient's

condition at step 706 and a treatment report including a prescribed treatment at step 707. Col. 25, ll. 39-52.

18. Joao describes the treatment report as outlining and prescribing treatment. Col. 25, ll. 47-49.
19. Joao also describes the treatment and diagnostic reports including suggestions for health and wellness foods, goods, products and services, and information on diets and nutrition. Col. 26, ll. 23-26.
20. Joao describes transmitting the diagnostic report and treatment report to the provider at step 708. Col. 25, ll. 54-56.
21. Joao states that while the preferred embodiment may be described as being utilized by a particular party, the invention can be used as well by a patient to perform self-diagnosis. Col. 4, ll. 34-39; col. 23, l. 65 – col. 24, l. 11; and col. 24, l. 65 – col. 25, l. 9.
22. Joao describes the patient communication device 40 including an output device 40I for outputting reports. Col. 22, ll. 58-60.
23. Joao also describes an embodiment in Figures 12A and 12B, which includes the central processing computer 10 directly notifying a doctor when a patient requires treatment and/or care. Col. 34, ll. 16-25 and 39-48.
24. Joao also suggests notifying a payer when a patient is admitted to a hospital or other care facility. Col. 34, ll. 57-59.

Hendee

25. Hendee, in Section 10.4.8, describes using a computer to filter information from a patient record to obtain only information that is relevant to a problem.

Campbell

26. Campbell describes an automated health care management system. Col 1, ll. 7-8.
27. Campbell describes that the system obtains information when checking a client and their pet into a veterinary hospital (Col. 9, ll. 44-46) and request that a client verify the information (Col. 9, ll. 65-66).
28. Campbell describes a Physical Examination Screen where information about the patient is recorded. Col. 12, ll. 9-12.
29. Campbell describes providing status boxes next to physical exam portions and coloring the box red when a nurse has marked abnormal findings for the doctor's review. Col. 13, ll. 48-50.
30. Campbell states "[h]owever, the features of the invention can also be used in human medical practices." Col. 1, ll. 59-61.

Any differences between the claimed subject matter and the prior art

31. Joao does not describe filtering patient data and discarding some of the patient data that is not related to the health condition.
32. Joao does not describe requesting correction or verification of the patient data with the user when the patient data appears abnormal.

The level of skill in the art

33. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of healthcare systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error

‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

34. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-9, 18-29, 38-46, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell and Handee.

Method Claims 1-9, 18-29

Turning to the first issue of whether Joao describes the claimed receiving and outputting steps, we find that claims 1 and 21 do not recite a self-care mechanism for a patient to manage his/her own diseases so that a medical recommendation is produced without physician input and is provided directly to the patient, as argued by the Appellants. Further, we

find that Joao does teach the limitations that actually are recited in the claims.

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “‘in view of the specification’” without importing limitations from the specification into the claims unnecessarily) (“The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims”).

Claims 1 and 21 both recite methods for managing diseases and wellness online, but neither claim recites a self-care mechanism for a patient to manage their own diseases nor do these claims require no physician input, as argued by the Appellants (Br. 9). However, we find that claims 1 and 21 do recite that a user that has a health condition (FF 1, 6) and that a medical recommendation is outputted directly to the user (FF 3, 9).

However, we find that Joao expressly teaches that a patient (i.e., a user with a health condition) instead of a doctor could also utilize Joao’s system to perform the method shown in Figures 7A and 7B. FF 21. For example, Joao states:

[w]hile the method of FIGS. 7A and 7B is described in the context of a medical doctor performing a diagnosis of a medical condition, the method of FIGS. 7A and 7B can be similarly utilized by surgeons, psychologists, psychiatrists, dentists, and/or any other healthcare provider or healthcare professional described herein. The method of FIGS. 7A and 7B may also be utilized by any user, *patient*, provider, payer, and/or intermediary in order to *ascertain a diagnosis*

and/or in order to check on, verify, and/or ascertain
the correctness of a diagnosis of another

(Col. 24, l. 67 – Col. 25, l. 9) (Emphasis added) and

[f]or example, a preferred embodiment for
determining and/or ascertaining a medical
diagnosis can be described as being utilized by a
treating physician as well as be utilized by a
provider to verify and/or check a diagnosis as well
as by a *patient or other user or individual* in order
to perform a *self-diagnosis* or double check a
doctors diagnosis

(Col. 24, ll. 2-8) (Emphasis added).

Further, the method of Figures 7A and 7B includes step 704, which has a provider inputting patient information into a central processing system (FF 15), and step 708, which has the central processing system outputting reports to the provider (FF 20). Therefore, if a patient was utilizing the method of Figures 7A and 7B as expressly taught in Joao, the patient would receive the reports and not the provider.

Therefore, we find that Joao describes outputting a medical recommendation directly to a user with a health condition as recited in claims 1 and 21.

Turning to the second issue, we find that the reports of Joao can be read as describing the claimed medical recommendations that include what the user is suggested to do in regards to the health condition. Both claims 1 and 21 recite “wherein the medical recommendation includes what the user is suggested to do in regarding [*sic.*] to the health condition.” FF 4, 9.

Joao describes the central processing computer outputting a diagnosis report and a treatment report. FF 17. The treatment report outlines or

prescribes a treatment (FF 18), can include suggestions for health and wellness foods, goods, products and services (FF 19), and can include diet and nutritional information. *Id.* We find that these are suggestions about what the user should do in regards to the health condition which are included in a treatment report (i.e., a medical recommendation).

Therefore, we find that Joao describes a medical report that includes what the user is suggested to do in regards to the health condition as recited in claims 1 and 21.

Turning to the third issue, we find that neither claim 1 nor claim 21 recites that related parties are automatically contacted if the data provided by the patient is abnormal, as argued by the Appellants (Br. 11).

We find that neither claim 1 nor claim 21 recite automatically contacting related parties *if the data provided by the patient is abnormal*. Claims 1 and 21 do recite “alerting automatically through the network related parties regarding the user if the health condition is deemed to be attended by professionals” (FF 5 and 10) and “requesting correction or verification on some of the patient data with the user when the patient data appear abnormal according to the first database” (FF 2 and 7).

“Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

We note that Joao describes the alerting step as recited in the claims. Joao describes the central processing system directly notifying a doctor when a patient requires treatment and/or care. FF 23-24.

Therefore, we find that the Appellants’ argument is drawn to a limitation that is not recited in the claims.

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1 and 21, and claims 2-9, 18-20, and 22-29 dependent thereon, under 35 U.S.C. § 103(a) as unpatentable over Joao, Campbell, and Hendee.

Article Claims 38-46 and 54

The Appellants state that the arguments made for independent claim 1 also apply for independent claim 38. Br. 14. As discussed above, we find the Appellants' arguments unpersuasive. We note that claims 38-46 and 54 recite a machine-readable medium that includes program code for executing the steps recited in claim 1 (FF 11) and that Joao describes a central processing computer 10 used in the method depicted in Figures 7a and 7b (FF 13-20).

Therefore, we conclude that the Appellants have not shown that the Examiner erred in rejecting claim 38, and claims 39-46 and 54 dependent thereon, under 35 U.S.C. § 103(a) as unpatentable over Joao, Campbell, and Hendee.

The rejection of claims 10-17, 30-37, and 47-53 under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell, Hendee, and LaPointe.

The Appellants have not separately argued the rejection of dependent claims 10-17, 30-37, and 47-53. Accordingly, they stand or fall with claims 1-9, 18-29, 38-46 and 54. Therefore, we reach the same conclusion as to the rejection of these claims, i.e., the Appellants have not shown error in the rejection of claims 10-17, 30-37, and 47-53.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-9, 18-29, 38-46, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell and Hendee and claims 10-17, 30-37, and 47-53 under 35 U.S.C. § 103(a) as being unpatentable over Joao, Campbell, Hendee, and LaPointe.

DECISION

The decision of the Examiner to reject claims 1-54 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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